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OFFICE OF PETITIONS

#19
AKD
11/21/00

Docket No: 7755/0D276



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Fiona Catherine MILLAR

Serial No.: 08/999,752

Art Unit: 1615

Filed: June 4, 1997

Examiner: R. Bawa

For: MEDICINAL AEROSOLS AND METHODS OF DELIVERY THEREOF

DECLARATION OF BERT J. LEWEN

Hon. Commissioner of
Patents and Trademarks
Washington, DC 20231

Sir:

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JUL 28 2000

TECH CENTER 1600/2900

I, Bert J. Lewen, declare as follows:

1. I am a member of the firm of Darby & Darby, P.C. and have been the responsible attorney handling the subject application since its inception. I make this declaration in support of the Petition under 37 C.F.R. 1.181(a) Requesting Withdrawal of a Holding of Abandonment to establish that no response was required to the Office letter of December 2, 1999.

2. By way of background, the subject application was finally rejected on December 2, 1999 (the "Final Rejection"). In order to gain allowance of the subject application, I arranged an interview with the Supervisory Examiner, Mr. Thurmond Page, on February 24, 2000. The interview was held with Exr. Page, since I was advised that the Examiner issuing the Office Action, Examiner R. Bawa, was on temporary leave of absence.

3. During the interview of February 24th, the Final Rejection was discussed. Upon examining the claims and the cited art, I was advised by Exr. Page that he was aware of prior art which he believed was more pertinent to the subject invention than the art upon which the Final Rejection was based. Furthermore, I was advised that, from his review of the subject matter and the Examiner's awareness of other applications pending in the office, there was a possibility that the subject application would become involved in an interference proceeding. On the basis of the foregoing, Exr. Page advised me that the Final Rejection would be withdrawn forthwith and that no further action or payment of extension fees was necessary on the applicant's part. Based on the foregoing discussion, I so advised my client and awaited the withdrawal of the Final Rejection. A copy of my February 25, 2000 memo to the file, a copy of which was sent to the client, is attached hereto as Exhibit A.

4. Since the withdrawal of the Office Action was not received by March 14, 2000, I called and spoke with Exr. Page, at which time he reiterated that he would be withdrawing the Final Rejection, apologizing for not having sent it sooner. A similar discussion was held on April 5, 2000, but still nothing in writing was

received. At the time of this discussion, Exr. Page advised me that the specific patents which he deemed relevant were U.S. Patent Nos. 4,174,295 and 5,653,962. Upon receiving this notification, I forwarded the references to my client with the assurance that the withdrawal of the Final Rejection would be forthcoming. This letter is attached hereto as Exhibit B.

5. On June 1, 2000, since the end of the six month period for response, June 2, 2000, was imminent and still nothing was received from the USPTO in writing, I again called and spoke with Exr. Page, stressing to him my concern. In this instance, he acted immediately and on that very same day forwarded to me the document attached hereto as Exhibit C which says on its face "that the Final Rejection ... is hereby VACATED". Having received this writing, I concluded that applicant no longer had an obligation to respond to the Final Rejection of December 2, 1999. I so reported this to my client (Exhibit D), with the expectation that I would be receiving another Final Rejection shortly.

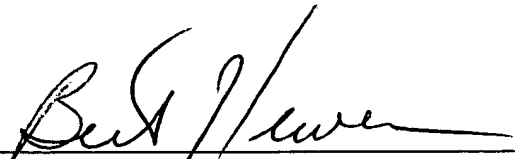
6. On June 28, 2000, to my surprise, I received the Notice of Abandonment from Exr. Bawa. A true copy of the Notice of Abandonment dated June 21, 2000 is attached as Exhibit E. The Notice of Abandonment states that the applicant failed to timely respond to the Office letter of December 2, 1999. I promptly called Exr. Bawa and advised him that, in my view, this holding of abandonment was inappropriate in light of the letter from the Supervisory Examiner that the Final Rejection was vacated. He advised me that there was no record in the file of the

communication I received from Exr. Page. Accordingly, I faxed a copy of the letter to him.

7. Despite his receiving this document, Exr. Bawa and subsequently Supervisory Examiner Dudash advised me that, while they regretted the foregoing problem, the document received from Exr. Page was insufficient to relieve applicant of the duty to respond and that I should petition for revival. It was not clearly explained to me why the document received from Exr. Page was insufficient.

All statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further these statements were made with the knowledge that willful and false statements and the like as made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Dated: July 18, 2000


Bert J. Lewen, Esq.

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